

Amendments to the Drawings:

The drawing sheets attached in connection with the above-identified application containing Figures 1-5 is being presented as a new formal drawing sheet to be substituted for the previously submitted drawing sheet. The drawing figures have been amended. Appended to this amendment is an annotated copy of the previous drawing sheet which has been marked to show changes presented in the replacement sheet of the drawing.

The specific changes which have been made to Figures 1 and 4 are that element 46 has been removed.

REMARKS

Applicant thanks the Examiner for acknowledging that claims 8-10, 13, 16-19, 22 and 25 contain allowable subject matter.

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Claims 1-5 are requested to be cancelled.

Claims 6, 14, 16 and 23 are currently being amended.

This amendment changes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

After amending the claims as set forth above, claims 6-25 are now pending in this application.

Drawing Objections

Figs. 1 and 4 were objected to for having element 46, which was not addressed in the specification. In response, Applicant has amended Figs. 1 and 4 to remove the number 46 from the figures. Accordingly, Applicant requests that the objection be withdrawn.

Claim Objections

Claims 14-22 were objected to for informalities. In response, Applicant has amended claims 14, 15 and 16 to correct the informalities. Accordingly, Applicant requests that the objections be withdrawn.

Claim Rejection under 35 U.S.C. § 112, First Paragraph

Claims 6-22 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for “a needle having luminescent lighting” or “a luminescent substance”, allegedly does not reasonably provide enablement for “a photophore substance.”

Applicant disagrees. Applicant submits that one of ordinary skill in the art, given the context and description of the specification would understand what is meant by photophore and would be enabled to make the invention. Further, given what is already known in the art, the disclosure and figures, one of ordinary skill in the art would be able to make and use the claimed invention without undue experimentation. To comply with 35 U.S.C. § 112, first paragraph, it is not necessary to "enable one of ordinary skill in the art to make and use a perfected, commercially viable embodiment absent a claim limitation to that effect." *CFMT, Inc. v. Yieldup Int'l Corp.*, 349 F.3d 1333, 1338, 68 USPQ2d 1940, 1944 (Fed. Cir. 2003).

Instead, the standard for determining whether the specification meets the enablement requirement was cast in the Supreme Court decision of *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916) which postured the question: is the experimentation needed to practice the invention undue or unreasonable? That standard is still the one to be applied. *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). Accordingly, even though the statute does not use the term "undue experimentation," it has been interpreted to require that the claimed invention be enabled so that any person skilled in the art can make and use the invention without undue experimentation. *In re Wands*, 858 F.2d at 737, 8 USPQ2d at 1404 (Fed. Cir. 1988). See also *United States v. Telectronics, Inc.*, 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988) ("The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation."). A patent need not teach, and preferably omits, what is well known in the art. *In re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991); *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986), *cert. denied*, 480 U.S. 947 (1987); and *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1463, 221 USPQ 481, 489 (Fed. Cir. 1984).

Thus, the rejection should be withdrawn at least because the proper standard has not been applied. Here, the Office Action does not assert that one of ordinary skill in the art could not make or use the claimed invention without undue experimentation. Instead, the rejection relies on the fact that one definition of photophore is a "light-producing organ found especially in marine fishes...." However, it is improper to conclude that a disclosure is not

enabling based on a single definition while ignoring the factors enumerated in *In re Wands*. Further, Applicant refers the Examiner to paragraph [0044] of U.S. Patent Publication No. 2008/0183028, which describes a photophore as a “frontal illumination system” for a lens. The examiner's analysis must consider all the evidence related to each of the *Wands* factors, and any conclusion of non enablement must be based on the evidence as a whole. 858 F.2d at 737, 740, 8 USPQ2d at 1404, 1407.¹ Accordingly, the rejection should be withdrawn.

Specification

The specification and abstract were objected to for use of the word “photophore.” In response Applicant refers the Examiner to the arguments set forth above and requests that the objection be withdrawn.

Claim Rejections under 35 U.S.C. § 103(a)

Claims 6, 7, 11, 12, 14, 15, 20, 21, 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0805340 to Sybrichs in view of US 5,797,345 to Evans, and US 6,653,567 to Ritter.

Independent claim 6 recites “an onboard indicator with luminous needle” comprising

¹ There are many factors to be considered when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is “undue.” These factors include, but are not limited to:

- (A) The breadth of the claims;
- (B) The nature of the invention;
- (C) The state of the prior art;
- (D) The level of one of ordinary skill;
- (E) The level of predictability in the art;
- (F) The amount of direction provided by the inventor;
- (G) The existence of working examples; and
- (H) The quantity of experimentation needed to make or use the invention based on the content of the disclosure.

In re Wands, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988).

“an arm rotatable with a light source, the dashboard electronic card configured to provide an energizing source for the light source, the light source comprising a support composed of flexible material having a first part and second part;”

“wherein the first part is covered with a photophore substance and is configured to be subjected to an electric voltage from the energizing source, and wherein the first part is linked electrically by a flexible link formed by the second part of the flexible support and wherein the second part extends around a hub of the indicator in a spiral and serves as substrate for at least two conducting tracks.” (emphasis added).

Independent claim 14 recites “a vehicle dashboard” comprising

“a dashboard electronic card;”

“an indicator mounted with respect to the dashboard electronic card;”

“a needle mounted with respect to the indicator and configured to illuminate; the needle comprising a rotatable arm comprising a light source, the dashboard electronic card configured to provide electric power to the light source;”

“a flexible support, comprising a first part and a second part, the first part having a photophore substrate, the second part extending around a hub of the indicator in a spiral, configurable to be flexible and to receive an electronic voltage from the dashboard electronic card; and”

“at least two conductive tracks coupled to the second part, wherein the second part is configured to electrically link the first part and the dashboard electronic card.” (emphasis added).

Independent claim 23 recites “a method of operating a needle of an onboard indicator suitable for a dashboard of a motor vehicle” comprising

“providing an electronic card, the electronic card configured to couple to the onboard indicator;”

“providing a light source, the light source rotatable and the electronic card configured to power the light source through at least two conductive tracks;”

“providing an electrically conductive support with pins mounted with respect to the electronic card, the pins configured to be in contact with at least one of the two conductive tracks;”

“providing a flexible electrical link between the conductive tracks and the electrically conductive support, wherein the flexible electrical link extends around a hub of the indicator in a spiral; and”

“powering the light source from the electronic card through the flexible electrical link.” (emphasis added).

The cited references, alone or in combination do not disclose, teach or suggest the combination of elements recited in independent claims 6, 14 and 23. The Office Action asserts that element 14 in Fig. 1 of Sybrichs corresponds to the claimed second part or flexible electrical link. Element 14 is a flexible printed circuit that is attached to pins 15 and 16 that are in electrical contact with a PCB. However, element 14 does not extend around the hub 13 of the indicator disclosed in Sybrichs in a spiral. Similarly, the pointer shown in Fig. 1 of Evans does not have a flexible second part that extends around the hub of the pointer in a spiral.

Accordingly, Sybrichs and Evans, alone or in combination, fail to disclose, teach or suggest that “the first part is linked electrically by a flexible link formed by the second part of the flexible support and wherein the second part extends around a hub of the indicator in a spiral and serves as substrate for at least two conducting track” (claim 6) , “a flexible support, comprising a first part and a second part, the first part having a photophore substrate, the second part extending around a hub of the indicator in a spiral, configurable to be flexible and to receive an electronic voltage from the dashboard electronic card” (claim 14) or “providing a flexible electrical link between the conductive tracks and the electrically conductive support, wherein the flexible electrical link extends around a hub of the indicator in a spiral” (claim 23). (Emphasis added).

Ritter fails to cure the deficiencies of Sybrichs and Evans. Accordingly, the cited references, alone or in combination, fail to disclose, teach or suggest each and every element of independent claims 6, 14 and 23. Therefore, the rejection should be withdrawn and claims 6, 14 and 23 should be allowed. Further, claims 7-13, 15-22, 24 and 25 depend from one of claims 6, 14 or 23 and are allowable for at least the reasons set forth above.

Conclusion

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing or a credit card payment form being unsigned, providing incorrect information resulting in a rejected credit card transaction, or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date 12/8/10

FOLEY & LARDNER LLP
Customer Number: 22428
Telephone: (202) 295-4623
Facsimile: (202) 672-5399

By W. Keith Robinson

W. Keith Robinson
Registration No. 59,396
Attorney for Applicant